

**REMARKS**

Claims 1-48 are pending in this application.

The examiner rejects claims 1-48.

Applicant thanks the examiner for granting an in-person interview with Applicant's representatives Won Joon Kouh (Reg. No. 42,763) and Peter Cronk (Reg. No. 32,021) on July 24, 2006 to discuss Applicant's proposed amendments to the claims. During the interview, Applicant's representatives discussed the features of the invention recited in the proposed amendments to the claims that distinguish the invention from the prior art of record as summarized in the examiner's Interview Summary.

Pursuant to the interview of July 24, 2006, Applicant hereby submits preliminary amendments to the pending claims as shown in the Listing of Claims, in conjunction with the accompanying Request for Continued Examination. Independent claims 1 and 22 and dependent claims 2, 3, 18, 26, 29, and 44 are amended. Claims 23, 24, and 48-55 are canceled without prejudice and a new claim 56 has been added.

After the entry of the amendments submitted herein, claims 1-22, 25-47, and 56 remain pending.

For the reasons presented below, Applicant believes that the amended claims are allowable over the prior art of record and place the present application in condition for allowance.

**Amendments to the Specification**

Pursuant to the examiner's suggestion, the units for the R-value that was added to paragraph [0017] of the Specification in the previously filed amendment is deleted as shown in the substitute paragraph [0017] submitted herein. Withdrawal of the objection are requested.

Furthermore, the paragraph [0002] of the Specification is amended to identify an additional related copending application.

**Claim Rejection Under 35 U.S.C. § 112**

The examiner rejects claim 48 under 35 U.S.C. § 112, first paragraph. In response, claim 48 has been canceled. Accordingly, Applicant believes that the §112 rejection is now moot. Withdrawal of the §112 rejection is requested.

**Claim Rejections Under 35 U.S.C. § 102**

Claims 1-4, 6-15, 18, 22-27, 32-41, and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States published Application No. 2003/0008586 to Kajander *et al.* ("Kajander"). Claims 23 and 24 have been canceled and, thus, their rejections are moot.

As for claims 1-4, 6-15, 18, 22, 25-27, 32-41, and 44, for the reasons discussed during the interview on July 24, 2006, as summarized in the Interview Summary, Applicant believes that these claims, as amended herewith, are allowable over the prior art of record including Kajander. For example, the independent claims 1 and 22 are amended to now recite that the scrap inorganic insulation fibers in the insulation material contain phenol/formaldehyde binder thereon, which is distinguishable from the prior art of record. The amendments to claims 1 and 22 are fully supported by the specification as originally filed and no new matter has been added. For example, support for these amendments can be found in the specification at paragraphs [0003] and [0029].

Furthermore, in reference to the facing limitation of claim 22, the examiner states in the Office Action that "Kajander et al. teach that the [] invention can have two or more layers of wood." And because "the invention of Kajander et al. may contain two or more layers, one of the layers would inherently be a facing layer." (Office Action at page 6). Applicant believes that this is an incorrect assumption. The wood layers of Kajander, between which the thin glass mat of Kajander is placed to hold adhesive for laminating the two wood layers, (Kajander at paragraph [0011]), would not be considered as a facing for the glass mat of Kajander by one of ordinary skill in the art. A facing for an insulation product such as the inorganic fiber insulation of the present case is bonded to the insulation product as a vapor barrier (*i.e.* moisture barrier) and to make the insulation product easier to handle. (See Specification as originally filed, for example, at paragraph [0017]).

Wood layers would absorb moisture rather than function as a barrier to moisture. And because of the stiffness of the wood layers, an inorganic fiber insulation product bonded to such a wood layer would not be useful or handleable as an insulation product. And as such, one of ordinary skill in the art would not consider a layer of wood as a facing for an insulation product.

At least for the reasons provided above, Kajander does not disclose each and every limitation of amended claims 1 and 22 and thus can not anticipate amended claims 1 and 22 and the claims depending therefrom under 35 U.S.C. § 102(b). Withdrawal of this rejection and allowance of claims 1-4, 6-15, 18, 22, 25-27, 32-41, and 44 are requested.

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 5, 16-17, 19-21, 30-31, 42-43, and 45-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kajander.

These claims depend from either claim 1 or claim 22 as amended, which are allowable over the Kajander reference as discussed above. Therefore, claims 5, 16-17, 19-21, 30-31, 42-43, and 45-47 as amended herein, because they incorporate all limitations of their parent claims, are also allowable over the Kajander reference and this rejection is moot.

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kajander in view of U.S. published patent application No. 2004/0266304 ("Jaffee"). In view of the amendments to the claims submitted herewith and the reasons presented below, Applicant believes that claim 28 is allowable over the cited references.

Claim 28 depends from claim 27 which, in turn, depends from amended claim 22 and thus claim 28 incorporates all limitations of the parent claims. As discussed above in reference to the rejection under 35 U.S.C. § 102, amended claim 22 is allowable over Kajander at least for the reason that Kajander does not teach or suggest scrap inorganic fibers containing phenol/formaldehyde binder thereon. And a close study of Jaffee shows that Jaffee's disclosure does not cure this deficiency of Kajander.

Accordingly, claim 28 is allowable over the cited references. Withdrawal of the rejection and allowance of claim 28 are requested.

**Other Amendments to the Claims:**

In addition to the amendments to the claims 1 and 22 discussed above, dependent claims 3 and 29 are also amended to correspond to the amendments made to claims 1 and 22. Support for the amendments to claims 3 and 29 can be found, for example, at paragraphs [0003] and [0029] of the specification as originally filed.

Claim 2 was amended to correct a typographical error and to maintain a consistent nomenclature for referring to the invention of claim 1 as "inorganic fiber insulation material." Claims 18 and 44 was amended to correct a typographical error. Claim 26 was amended to correct the dependency of the claim. Claims 30-34 were amended to refer to the glass fibers as "scrap glass fibers" consistent with the amendment made to their parent claim 22. None of these amendments add new matter.

**New Claim:**

A new claim 56 depending from claim 22 has been added. The support for the new claim 56 can be found, for example, at paragraph [0044] of the specification as originally filed.

**Terminal Disclaimers**

Applicant submits terminal disclaimers with respect to the following three (3), commonly assigned, copending applications: Serial No. 10/823,065, filed on 04/12/2004; Serial No. 10/781,994, filed on 02/19/2004; and Serial No. 10/806,544, filed on 03/23/2004. Applicant hereby authorized the Commissioner of Patents to charge the terminal disclaimer fee of \$130 for each of the three accompanying terminal disclaimers for a total of \$390 to Duane Morris LLP Deposit Account No. 04-1679.

**CONCLUSION**

Applicants believe that the pending claims as amended are in condition for allowance. Reconsideration of the present application, withdrawal of the rejections and allowance of the pending claims are kindly requested. Should the examiner disagree with the Applicant's position,

then a telephone interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No additional claim fee is believed due for the filing of this amendment and response.

Respectfully submitted,

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s/ Won Joon Kouh

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